

**REMARKS****STATUS OF THE CLAIMS:**

Claims 1 to 20 are cancelled.

Claims 23, 25, 28, 31, 32, 34, and 36 have been amended.

Claims 21 to 36 are pending.

Claim 23 was amended to correct a typographical error by substituting the dependency from Claim "33" to Claim "22". Support for this amendment may be found in original Claim 1. Applicants right to equivalents of Claim 23 is reserved. No new matter has been added.

Claim 25 was amended to correct a typographical error by substituting the dependency from Claim "35" to Claim "24". Support for this amendment may be found in original Claim 1. Applicants right to equivalents of Claim 25 is reserved. No new matter has been added.

Claim 28 was amended to substitute the phrase "said polypeptide" to "a polypeptide comprising either amino acids 1 to 387 of SEQ ID NO:2 or amino acids 2 to 387 of SEQ ID NO:2" to overcome the Examiner's objection to the same. Support for this amendment may be found in Claim 21 as originally presented. Applicants right to equivalents of Claim 28 is reserved. No new matter has been added.

Claim 31 was amended to substitute the phrase "a polynucleotide sequence provided in claim 21" to "nucleotides 61 to 1218 of SEQ ID NO:1" to overcome the Examiner's objection to the same. Support for this amendment may be found in Claims 21, 25, and 31 as originally presented. Applicants right to equivalents of Claim 31 is reserved. No new matter has been added.

Claim 32 was amended to append the phrase "encoding a polypeptide" to overcome the Examiner's rejection to the same. Support for this amendment may be found on pages 7, 28, 35 to 37, 56 to 57, of the specification. Applicants right to equivalents of Claim 32 is reserved. No new matter has been added.

Claim 34 was amended to substitute the phrase "nucleic acid molecule" with the "polynucleotide" term to overcome the Examiner's rejection to the same and to ensure proper antecedent basis is maintained. Applicants right to equivalents of Claim 34 is reserved. No new matter has been added.

Claim 36 was amended to substitute the incorrect dependency to Claim "20" to the correct dependency to Claim "21" to overcome the Examiner's objection to the same. Support for this amendment may be found in original Claim 1 as originally filed.. Applicants right to equivalents of Claim 36 is reserved. No new matter has been added.

**I. Miscellaneous****a. Objections to the Specification**

The Examiner has objected to the specification stating

2) The disclosure is objected to because the text "Deposit Number XXXXX" in line 28 on page 7 is incorrect.

In response, Applicants point out to the Examiner the amendments to the specification presented in the Preliminary Amendment submitted on October 11, 2005. Specifically, Applicants substituted the "XXXXX" term on page 7, line 28 with "PTA-5853" in an amendment to the paragraph in which this line resides (see page 2). Applicants also amended Table I to reflect this amendment as well.

Applicants believe all of the Examiner's objections to the specification have been addressed.

**b. Objections to the Claims**

The Examiner has objected to Claims 31 and 36 stating

3) Claims 31 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A properly dependent claim can not conceivably be infringed without infringing any of the claims from which it depends. See M.P.E.P. 608.01(n)111. Claim 31 is improper because it can be infringed by an isolated nucleic acid molecule that does not infringe claim 21. Claim 36 is improper because it depends from a cancelled claim.

In response, Applicants have amended Claim 31 to substitute the phrase "a polynucleotide sequence provided in claim 21" with the phrase "nucleotides 61 to 1218 of SEQ ID NO:1". In addition, Applicants have amended Claim 36 to substitute the dependency of Claim "20", to the dependency of Claim "21". Applicants believe the Examiner's objection to Claims 31 and 36 have been overcome in consideration of these amendments.

The Examiner has objected to Claims 25 and 35 stating

4) Applicant is advised that should claim 35 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

In response, Applicants point out that Claim 25 had a typographical error in the claim dependency and that it was intended that Claim 25 depend from Claim 24 and not Claim 35. Claim 25 was amended to correct this error. Applicants believe the Examiner's objection to Claims 25 and 35 have been overcome in consideration of this amendment.

**c. Public Access to ATCC Deposit No. PTA-5853**

Applicants representative hereby gives the following assurance by signature below:

Bristol-Myers Squibb Company, an assignee of the present application, has deposited biological material under the terms of the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure with the following International Depository Authority: American Type Culture Collection (ATCC), 10801 University Boulevard, Manassas, Virginia 20110-2209. This deposit comprises the cDNA clone HM74B, that encodes the full-length HGPRBMY74 polypeptide of the present invention. The deposit for the HM74B clone was made on March 10, 2004, and given ATCC Accession Number PTA-5853. In accordance with MPEP 2410.01 and 37 C.F.R. § 1.808, assurance is hereby given that all restrictions on the availability to the public of ATCC Accession Number PTA-5853 will be irrevocably removed upon the grant of a patent based on the captioned application, except as permitted under 37 C.F.R. § 1.808(b).

Applicants representative also hereby gives the following additional assurance by signature below:

In accordance with 37 C.F.R. § 1.805 to § 1.807, assurance is hereby given that the viability of the deposit for the HM74B clone, made on March 10, 2004, and given ATCC Accession Number PTA-5853, will be maintained during the pendency of the captioned application for a duration of at least 30 years or at least five years after the most recent request

for the furnishing of a sample of the deposit is received by the ATCC, or whichever is longer; and that the deposit will be replaced if it should ever become inviable.

**II. Rejections under 35 U.S.C. § 112, first paragraph**

a. The Examiner has rejected Claims 25 and 35 under 35 U.S.C. § 112, first paragraph, alleging that these claims fail to comply with the enablement requirement and contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More particularly, the Examiner alleges

. . . Applicant, their assignee or their agent needs to provide a declaration containing the following:

The identification of the declarant.

A statement that a deposit has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.

A statement that the deposited material has been accorded a specific, recited, accession number.

A statement that the material has been deposited under conditions that assure that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 C.F.R. 1.14 and 35 U.S.C. ' 122.

A statement that the deposited material will be maintained with all of the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty years after the date of deposit or for the enforceable life of the patent, whichever period is longer.

A statement by declarant that all statement made therein of declarant's knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternately, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (e.g., see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent. Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession number) number, name and address of the depository, and the complete taxonomic description.

In response, Applicants representative has provided the required assurance in the "Miscellaneous" section of Applicants Reply *supra*. Since the ATCC deposits have been submitted in accordance with the Budapest Treaty, Applicants do not believe they need to provide explicit assurances that access to the invention will be afforded to the Commissioner upon request during the pendency of the application. Applicants believe the Examiner's rejection of Claim 35 under 35 U.S.C. § 112, first paragraph has been overcome in consideration of Applicants assurances provided herein.

Relative to Claim 25, Applicants have corrected the typographical error that caused this claim to depend from Claim 35 as opposed to depending from Claim 24. Accordingly, Applicants believe the Examiners rejection of Claim 25 under 35 U.S.C. § 112, first paragraph has also been overcome in consideration of Applicants amendment.

### **III. Rejections under 35 U.S.C. § 112, second paragraph**

a. The Examiner has rejected Claims 28, 32, 34, and 36 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner has rejected Claim 28 stating

7.1) Claim 28 is vague and indefinite because the identity of the polypeptide being produced by the claimed method is not specified. The act of culturing a host cell inherently results in the production of thousands of different polypeptides.

Applicants disagree with the Examiner's allegation and point out that Claim 28 ultimately depends from Claim 21 and that it is clear that the phrase "said polypeptide" refers to either the

polypeptide comprising "amino acids 1 to 387" or "amino acids 2 to 387" of SEQ ID NO:2. However, in the sole interest of facilitating prosecution, Applicants have amended Claim 28 to explicitly state the latter by substituting the phrase "said polypeptide" with the phrase "a polypeptide comprising either amino acids 1 to 387 of SEQ ID NO:2 or amino acids 2 to 387 of SEQ ID NO:2". Applicants believe the Examiner's rejection of Claim 28 under 35 U.S.C. § 112, second paragraph has been overcome in consideration of this amendment and respectfully request that the Examiner withdraw the same.

The Examiner has rejected Claim 32 stating

7.2) Claim 32 is confusing because it is unclear how a polynucleotide can be "at least 97% identical" to an amino acid sequence.

In response, Applicants have amended Claim 32 to append the phrase "encoding a polypeptide" after the "polynucleotide" term. Applicants believe the Examiner's rejection of Claim 32 under 35 U.S.C. § 112, second paragraph has been overcome in consideration of this amendment and respectfully request that the Examiner withdraw the same.

The Examiner has rejected Claim 34 stating

7.3) Claim 34 is vague and indefinite because there is no antecedent basis for "the isolated nucleic acid molecule of claim 33". Claim 33 is drawn to "an isolated polynucleotide".

In response, Applicants have amended Claim 34 to substitute the phrase "nucleic acid molecule" with the term "polynucleotide". Applicants believe the Examiner's rejection of Claim 34 under 35 U.S.C. § 112, second paragraph has been overcome in consideration of this amendment and respectfully request that the Examiner withdraw the same.

The Examiner has rejected Claim 36 stating

7.4) Claim 36 is vague and indefinite because it depends from a canceled claim.


In response, Applicants have amended Claim 36 to substitute incorrect dependency from Claim "20" to the correct dependency to Claim "21". Applicants believe the Examiner's rejection of Claim 36 under 35 U.S.C. § 112, second paragraph has been overcome in consideration of this amendment and respectfully request that the Examiner withdraw the same.

Applicants believe that all of the Examiners rejections and objections have been overcome and that all of the pending claims before the Examiner are in condition for allowance. An early Office Action to that effect is, therefore, earnestly solicited.

If any fee is due in connection herewith not already accounted for, please charge such fee to Deposit Account No. 19-3880 of the undersigned. Furthermore, if any extension of time not already accounted for is required, such extension is hereby petitioned for, and it is requested that any fee due for said extension be charged to the above-stated Deposit Account.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-5289

  
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Stephen C. D'Amico  
Agent for Applicants  
Reg. No. 46,652

Date: December 21, 2005